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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,708	07/08/1999	CHARLES WILLIAM BERTHOUD	BERTHOUD-16-	7016

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EXAMINER

BUI, BING Q

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/349,708

Applicant(s)

BERTHOUD ET AL.

Examiner

Bing Q Bui

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-44 is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's amendment filed on 8/10/2004 has been entered. Claims 1, 12, 18, 19 and 25 have been amended. No claims have been cancelled. Claims 1-44 are still pending in this application, wherein claims 1, 12, 18, 19, 25, 26, 33 and 39 being independent.

#### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: [ said ] followed by "remote" in line 9 should be deleted and replaced with -- a --; and [ a ] followed by "remote" in line 10 should be deleted and replaced with -- said --.

Appropriate correction is required.

#### ***Response to Arguments***

3. Applicant's arguments filed 8/10/2004 have been fully considered but they are not persuasive.

Applicant mainly argues that the combination of Smock and O'Donovan fails to disclose or suggest a method and apparatus sending a personalized message to a called-but-busy party and an Internet user while the called-but-busy party and the Internet user is connected to an Internet, as recited by claims 1-5, 8-15, 17-22, 24 and 25 (Applicant's Remarks, page 14, lines 7-11 and 22-26).

Examiner agrees with the recited arguments since the combination of Smock and O'Donovan solely dealing with only two parties such as calling party and called-but-

busy party , instead of three parties such as calling party, called-but-busy party and Internet user as indicated in the forementioned arguments (e.g., ...sending a personalized message to ***a called-but-busy party and an Internet user ...*** ).

However, Examiner could not find more than two parties (e.g., “a calling party and called-but-busy” **OR** “a calling party and an Internet user”) associated with a call in the recited claims.

For above reasons, Examiner respectfully maintains his ground of rejection with Smock and O'Donovan.

#### ***Claim Rejections - 35 USC § 103***

4. Claims 1-5, 8-15, 17-22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smock et al (US Pat No. 6,377,668) in view of O'Donovan et al (US Pat No. 6,396,908), herein after referred as Smock and O'Donovan.

**Regarding claim 1**, with respect to Figure 1, Smock teaches the invention as claimed, a system for notifying a called-but-busy party 16 of an incoming telephone call attempt over a telephone line while the called-but-busy party 16 is accessing the Internet over the same telephone line 50, comprising:

Internet communication module (Fig 1, element 68 and col 3, ln 8-34); and

a message formatter (Fig 1, element 64 and col 3, ln 66-col 4, ln 4);

wherein said Internet communication module is adapted to cause said message formatter to send a notification message (e.g. announcing the name and telephone

number of the caller) to said called-but-busy party upon request from a caller (remote telephone user) while said called-but-busy party is connected to said Internet (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

Smock fails to teach an internet communication module to send a personalized notification message recorded by a remote telephone user (caller or calling party) to the called-but-busy party via TCP/IP protocol over the internet. However, O'Donovan teaches a system that enabling a calling party to record a message directed to a called party when the called party is not instantly available for receiving the call and the recorded message to be transmitted to the called party via a data network such as internet (see Fig 1 and Abstract). Therefore, integrating O'Donovan's teachings into communication system of Smock would have been obvious for saving toll charge and reducing the amount of voice traffic on the voice communication lines.

**Examiner's Remarks:** Examiner uses Smock and O'Donovan on the ground that the claimed invention does not show any indication that the personalized message have to be real time or instantly delivered to a called party who is being busy on an Internet session.

**Regarding claim 2,** with respect to Figure 1, Smock teaches the invention as claimed, an apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1 (Fig 1 and Abstract); Smock et al do not explicitly teach ,the remote telephone user is a central office; however, as it can be seen by an ordinary skill in the art, an incoming call transparently comes from a

different or the same central office with the called-but-busy party via phone line 10 (Fig 1 and col 3, ln 8-45).

**Regarding claim 3**, with respect to Figure 1, Smock teaches the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line 50 while the called-but busy party is accessing the Internet over the same telephone line 50 according to claim 1, wherein said remote telephone user is a party trying to establish a telephone call with said called-but-busy party (Abstract; Fig 1 and col 2, ln 28-40).

**Regarding claim 4**, with respect to Figure 1, Smock teaches the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising:

a call related information receiver 32 (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4);

wherein call related information regarding a calling party is included with said notification message (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4).

**Regarding claim 5**, with respect to Figure 1, Smock teaches the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said call related information receiver is a Caller ID receiver (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4).

**Regarding claim 8**, with respect to Figure 1, Smock teaches the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising said notification message includes an audibly playable data file (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 9**, with respect to Figure 1, Smock teaches the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said audibly playable data file automatically plays when received on a computer terminal of said called-but-busy party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 10**, with respect to Figure 1, Smock teaches the invention as claimed, apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising: a data signal detector adapted to detect likely Internet usage of said called-but-busy party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 11**, with respect to Figure 1, Smock teaches the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 10, wherein said notification

message includes information regarding likely Internet usage of said called-but-busy party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**As to claims 12 and 18**, they are rejected for the same reasons set forth to rejecting claim 1 above, since claims 12 and 18 are merely a method of operation for the system defined in the system claim 1.

**Regarding claim 13**, with respect to Figure 1, Smock teaches the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising receiving a notification request from said calling party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 14**, with respect to Figure 1, Smock teaches the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising receiving a notification request from a central office (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 15**, with respect to Figure 1, Smock teaches the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising determining at a central office a likelihood that said Internet user is connected with said Internet (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 17**, with respect to Figure 1, Smock teaches the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party



is attempting to connect with said Internet user according to claim 12, wherein said notification is an audibly playable message (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**As to claims 19-22**, they are rejected for the same reasons set forth to rejecting claims 12-15, respectively.

**As to claim 24**, it is rejected for the same reasons set forth to rejecting claim 8.

**As to claim 25**, it is rejected for the same reasons set forth to rejecting claim 1.

5. Claims 6-7, 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smock (US Pat No. 6,377,668) in view of O'Donovan (US Pat No. 6,396,908), and further in view of Bajzath (US Pat No. 6,144,644), herein after referred as Bajzath.

**Regarding claims 6-7, 16 and 23**, the combined system of Smock and O'Donovan teaches the invention substantially as claimed, with the exception of providing the notification message sent to an internet user and displayed on internet user's computer terminal in the form of text. However, Bajzath teaches the notification message sent to an internet user and displayed on internet user's computer terminal in the form of text (see Fig. 6A, steps "650"- "660" and col. 6, lns 33-41). Therefore, integrating Bajzath's teachings into the combined system of Smock and O'Donovan would have been obvious for providing internet user more flexibility in receiving the call waiting notification.

***Allowable Subject Matter***

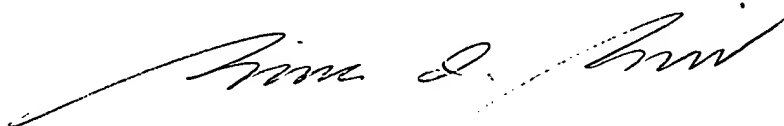
6. Claims 26-44 are allowed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 and for formal communications intended for entry (please label the response "EXPEDITED PROCEDURE") or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

16 Jan 2005

A handwritten signature in black ink, appearing to read "Bing Q. Bui", written in a cursive style.

**BING Q. BUI  
PRIMARY EXAMINER**